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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,121	08/18/2003	David H. Sprogis	5014CON3	3471
7590 12/19/2008				
William E. Hilton, Esq. Gauthre & Connors, LLP 225 Franklin street, Suite 2300 Boston, MA 02110				
EXAMINER				
CARLSON, JEFFREY D				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
12/19/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/643,121

Applicant(s)

SPROGIS, DAVID H.

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-15 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/CDC)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

This action is responsive to the paper(s) filed 9/30/2008.

1. The affidavit filed on 9/30/2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hunter reference.

Conception

2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

- Applicant has provided essentially a list of dates for files and documents, but no copies or showing of facts regarding the content of those files. Examiner cannot verify conception without facts to demonstrate which **claimed features** were indeed possessed prior to the critical date. While applicant's appendices of file listings have been described as being *associated* with different portions of the specification and/or figures, no particular guidance has been provided demonstrating particular claimed features.

From MPEP 715.07 I: The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory

evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.

...

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. **Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts"** and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). **Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established** and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (**Affidavit "asserts that facts exist but does not tell what they are or when they occurred."**).

Actual Reduction To Practice

Applicant states that "the system first became operational" on 3/17/2000, yet it is not clear what "the system" included? Where are the facts that demonstrate that all of the claimed features were present at this demonstration? It is noted that examiner could not access the referenced video at <http://www.cinecast.com/press/htm> [sic], nor at <http://www.cinecast.com/press.htm>, nor at <http://www.cinecast.com/press.html>. Although <http://www.cinecast.com/> was accessed and browsed, the referenced video was not located by the examiner from any of the links explored.

Therefore, it is not clear whether the claimed invention was ever actually reduced to practice on this or any other date, save for on a patent filing date.

Art Unit: 3622

Diligence

3. It is assumed that applicant did not reduce to practice the invention prior to the critical date of Hunter. Therefore applicant is assumed to be attempting to show prior conception coupled with due diligence until either a constructive reduction to practice or to an actual reduction to practice.
4. While diligence need not be addressed at this time, examiner finds at least the following concerns regarding diligence. This represents a cursory review of the diligence evidence and the examiner may find further faults with the diligence evidence when it is appropriate to analyze diligence in more detail (i.e. when conception has been properly shown).

MPEP 715.07(a): In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

5. Again, applicant's evidence basically shows a collection of file listings and dates, but no particular facts regarding *activities* or the *subject matter* of any activities – and therefore diligence cannot be determined. Was the activity merely "related" to the subject matter? Or related to commercial exploitation? What was the activity that caused the files to be modified? Activities directly involved in a reduction to practice or to prepare the case for a patent application filing? Or trivial actions like file maintenance or spell checks?

From MPEP 2138.06: **An applicant must account for the entire period during which diligence is required.** *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that

Art Unit: 3622

there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). **A 2-day period lacking activity has been held to be fatal.** *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) **(Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice.** An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

...

The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. It is not sufficient that the activity relied on concerns related subject matter." *Gunn v. Bosch*, 181 USPQ 758, 761 (Bd. Pat. Inter. 1973)

Art Unit: 3622

6. Diligence must be shown to be "continuous".

From MPEP 715.07 III: applicant or patent owner must also show diligence in the completion of his or her invention from a time just prior to the date of the reference **continuously up to the date** of an actual reduction to practice or up to the date of filing his or her application (filing constitutes a constructive reduction to practice, 37 CFR 1.131).

From MPEP 715.07(a): An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that **the record must set forth an explanation or excuse for the inactivity**; the USPTO or courts will not speculate on possible explanations for delay or inactivity

7. Even with the questions regarding the file dates presented, there are substantial gaps in time that have not been accounted for. The following represent the largest gaps of unexplained time – smaller gaps are not necessarily "excused" gaps however.

Gap ending on	gap (days)
5/11/99	15
6/25/99	41
8/31/99	55
9/20/99	20
11/9/99	28
12/6/99	27
1/24/00	41
4/17/00	23
5/19/00	18
6/2/00	14
7/5/00	15

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Hunter (US6424998).

10. Regarding claims 1-5, Hunter teaches remote distribution of advertising over a network to be displayed at screen locations, including locations inside a movie theater [abstract, col 3: lines 58-67]. Hunter further teaches that an advertiser uploads the advertising content to a central host where a subset of the content is automatically selected for display on a remote screen location at a certain time [col 4: lines 11-21]. The video advertising [4:24] is then downloaded to the remote location for display. Hunter teaches that projectors may be used for displaying the content on a screen [10:33-38]. The scheduling system of Hunter provides a means for assembling presentation data at the respective screens and at the proper times. Hunter teaches that not only is a log kept by the display apparatus indicating which ads have been shown [4:60-63], a traffic count (i.e. a number of audience viewers – attendance data) is created and used along with analysis to report to the advertising customer regarding the number and types of viewers that were present for each showing of the advertisement

[5:1-15]. This provides an informative report for the advertising client and his advertising billing.

11. Regarding claims 6, 7, Hunter's system provides for the ability to deliver advertising during two same time slots (i.e. same show times) in different locations as well as different time slots (show times) for the same location.

12. Regarding claims 8, Hunter's advertiser user interface provides a means for requesting job requests for presentation of video data and which can be described as determining of a job request will be fulfilled.

13. Regarding claims 9-15, the system of Hunter allows for multiple job requests for multiple presentations for multiple show times and locations and would include multiple attendance data collection, presentation logging and correlation as described for the single usage example above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

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Art Unit 3622